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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,674	07/10/2003	Carl A. Forest	13194.102US	2594

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EXAMINER	
EBRAHIM, NABILA G	

ART UNIT	PAPER NUMBER
1618	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/616,674	FOREST, CARL A.	
	Examiner	Art Unit	
	Nabila G. Ebrahim	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 July 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6 and 9-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 9-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Receipt of Applicant's remarks and amendments to the claims dated 7/2/07 is acknowledged.

Status of Claims

Claims 1-6 and 9-30 are pending in the application.

Claims 7 and 8 were cancelled.

Status of Office Action: Non-Final

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-6 and 9-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a new matter rejection**.

The claim recites "said weight loss supplement not including a fat blend". The instant specification does not have support to the phrase recited in claims 1 and 26.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1-6 and 9-28 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. The claims as amended recite "fat blend", it is not clear what does the Applicant mean by the fat blend and the specification does not define a fat blend to explain the claims. The claims are ambiguous reciting "said weight loss supplement not including a fat blend" because it does not clearly demonstrate what the phrase excludes.

Claim Rejections - 35 USC § 102

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

In view of the amendments to instant claim 1 (**IF APPLICANT CAN SHOW SUPPORT FOR THE AMENDMENTS**) the rejection under 35 U.S.C. 102(b) as being anticipated by Sundram et al. US 20020034562 (Sundram) for the reasons set forth in the office action mailed 9/18/06 is withdrawn.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6, 9-30 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Sundram et al. US 20020034562 in view of McCleary US 6,579,866 (McCleary), Hastings US 5626849 (Hastings), and further in view of Dente US 6277396 (Dente) for the reasons set forth in the office action mailed 9/18/06.

It is noted that the amendments to claims 1 and 26 would not exclude the prior art used in the rejection since it is known to people skilled in the art as well as to the public that fatty food ingredients are a good factor in gaining weight. Accordingly, it would have been obvious to one of ordinary skill in the art to exclude the fatty blends form the composition of the prior art.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 9, 12-23, and 25-30 remain rejected on the ground of nonstatutory double patenting over claims 1-9, and 14-24 of U. S. Patent No. 6579866 (McCleary) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

3. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: McCleary's composition comprised the same ingredients of the instant application (hydroxycitric acid; an effective amount of carnitine; an effective amount of biotin; and an effective amount of one or more gluconeogenic substrates selected from the group consisting of aspartate, lactate, glycerol, and a gluconeogenic amino acid or alphaketo analogue thereof; the improvement comprising the addition of an effective amount of eicosapentanoic acid.) and also the same methods (method of losing weight, method of losing weight for a human following a dietary regiment involving glycemic index of less than 60, said human following exercise and aerobic training, a method for a human who donate blood so as to produce a fall in serum ferritin levels, and a method for a human follow a stress reduction program).

Accordingly, the instant application claims encompass McCleary's compositions and methods.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Declaration

4. The declaration under 37 CFR 1.132 filed 7/2/07 is insufficient to overcome the rejection of claims 1-6 and 9-28 based upon USC §103 as set forth in the last Office action because:

It is noted that the unexpected results reported by the Affiant, which is the "taste", is not in the scope of the instant claims. In addition, "taste" is not within the expertise of a medical doctor to decide. Taste is a relative characteristic that may differ between one person and the other. It is also noted that though Affiant claims that a medical doctor would not consider salad dressing as a carrier for a medicine, combining medicines to drinks and foods including salad dressing is well known in the art evidenced by:

- Patent application 20040043013 to McLeary (the Affiant) discloses adding metabolic uncoupling therapy (MUT) to salad dressing.
- US 20040072765 which discloses cardiovascular and bone treatment using isoflavones wherein the medicines may be administered to a human in a dietary supplement form such as foods or drinks. Any food may be used including, but not limited thereto, meats, marinated meats; beverages such as nutritional beverages, sports beverages, protein fortified beverages, juices, milk, milk alternatives, and weight loss beverages; cheeses such as hard and soft cheeses, cream cheese, and cottage cheese; frozen desserts such as ice cream, ice milk, low fat frozen desserts, and non-dairy frozen desserts; yogurts; soups; puddings; bakery products; salad dressings; and dips and spreads such as mayonnaise, margarine, butter, butter substitute, and other fat containing spreads,.

- Also US 6849281 that discloses food product suitable for reducing low density lipoprotein cholesterol levels and the composition is added to food products including salad dressing.

These references are examples of how people skilled in the art would consider salad dressing as a carrier for medicines and/or nutritional supplements.

5. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Response to Arguments

6. Applicant's arguments filed 7/2/07 have been fully considered but they are not persuasive. Applicant argues as follows:

The office action states that McCleary teaches that the supplement can be administered orally as suspension in water, powder, or chewable wafer and does not exclude using any food or drink. However, the patent law requires that the references teach the invention, not that the references specifically exclude what is claimed.

To respond: this was not found persuasive because Sundram teaches clearly that it is possible to use salad dressing as a carrier for a composition administered to achieve health advantage such as to increase the HDL level and the HDL/LDL ratio in human serum. In addition, Sundram's disclosure reveals that salad dressing is another conventional method for adding a composition to foods and drinks to be administered to humans.

Double Patenting

McCleary only contemplated conventional methods of administration of supplements is known by medical doctors, and specially does not teach the combination with foods and drinks, and in particular, salad dressings. See Declaration of Edward Larry McCleary. Moreover, the combination of the weight loss supplement results in completely unexpected by McCleary.

To respond: it is noted that people skilled in the art administer different medicinal compositions to different foods and drinks and consider salad dressing as a kind of food as shown above. In addition, it is respectfully submitted that the unexpected results reported by McCleary is not within the scope of the instant claims. It is also noted that tasting a salad dressing would differs between one consumer and the other and not every person would agree regarding taste.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabila G. Ebrahim whose telephone number is 571-272-8151. The examiner can normally be reached on 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nabila Ebrahim
8/30/07

MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER